

FEB 14 2005 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Re: Appeal to the Board of Patent Appeals and Interferences

In re Application of: Grover Blackwell

Serial No.: 09/888,044

Filed: June 22, 2001

For: Reinforced Window Shutter

Sir:

Group Art Unit: 1772

Examiner: Jane J. Rhee

Our Customer ID: 22827

Our Account No.: 04-1403

Attorney Ref.: NHS-2

1. **NOTICE OF APPEAL:** Pursuant to 37 CFR 41.31, Applicant hereby appeals to the Board of Appeals from the decision dated _____ of the Examiner twice/finally rejecting claims _____.
 BRIEF on appeal in this application pursuant to 37 CFR 41.37 is transmitted herewith (1 copy)
3. An **ORAL HEARING** is respectfully requested under 37 CFR 41.47 (due within one month after Examiner's Answer).
4. Reply Brief under 37 CFR 41.41(b) is transmitted herewith (1 copy).
5. "Small entity" verified statement filed: herewith previously.

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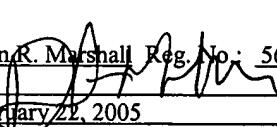
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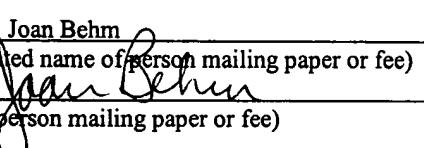
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By: Alan R. Marshall Reg. No. 56,405
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Date: February 22, 2005

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, U.S. Patent and Trademark Office, Post Office Box 1450, Alexandria, VA 22313-1450, on February 22, 2005.

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PATENT

ATTORNEY DOCKET NO.: NHS-2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Blackwell et al)	Group Art Unit: 1772
)	
Serial No.: 09/888,044)	Examiner: Jane J. Rhee
)	
Filed: June 22, 2001)	Deposit Account No.: 04-1403
)	
Title: Reinforced Window Shutter)	

BRIEF ON APPEAL

Commissioner of Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants submit herewith the following Brief on Appeal in accordance with 37 C.F.R. §41.37:

1. Real Party in Interest

The real party in interest in this matter is the Assignee of Record, New Horizon's Shutters, Inc.

2. Related Appeals and Interferences

There are no other appeals or interferences known to the Appellants or the Appellants' legal representatives which will directly affect or be directly affected by or have a bearing on the Board's decision in the appeal.

3. Status of the Claims

Claims 1-20 are currently pending in the present application, including independent claims 1, 11, and 17. All of the pending claims are attached hereto as Exhibit A.

4. Status of Amendments

To the Appellant's knowledge, all amendments filed by the Appellants have been entered into the record.

5. Summary of the Claimed Subject Matter

Generally, the presently pending claims are directed to a window shutter. Independent claims 1, 11, and 17 are all directed to a shutter that includes a face panel attached to a first rear vertical support and a second rear vertical support. The face panel is made from a synthetic polymer.

All of the claims further require a first channel member and a second channel member that have a U-shaped cross section. According to the specification, the first and second channel members better secure the face panel to the rear vertical supports. Pg. 9, ll. 3-12. For instance, the first and second channel members enclose the vertical edges of the shutter in order to consolidate the entire structure.

Claims 1, 11 and 17 all require that the channel members be made from a metal. All of the claims further require that the first and second channel members form the exterior vertical edges of the shutter. Thus, the exterior vertical edges of the shutter are made from a metal.

Referring to Figs. 1 and 2, first channel member 42 and second channel member 44 are shown enclosing the vertical edges of the shutter 10.

6. Grounds of Rejection to be Reviewed on Appeal

In the Final Office Action, claims 1-20, including independent claims 1, 11 and 17, were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,848,505 to Taylor in view of U.S. Patent No. 6,014,839 to Ruggles.

7. Arguments

In comparison to the presently claimed invention, Taylor fails to disclose or suggest channel members made from a metal that form the exterior edges of a shutter. Taylor is directed to a shutter that is substantially comprised of polyvinyl chloride. As

opposed to the currently pending claims, Taylor teaches to construct the entire exterior surfaces of the shutter exclusively from polyvinyl chloride.

A. Taylor teaches away from the presently claimed construction.

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of prima facie obviousness to determine whether it has been properly made. For instance, “a prima facie case of obviousness can be rebutted if the applicant can show that the art in any material respect taught away from the claimed invention.” In re Haruna, 249 F.3d 1327, 1335 (Fed. Cir. 2001), citing In re Geisler, 116 F.3d 1465, 1469 (Fed. Cir. 1997).

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994). Furthermore, a “prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” M.P.E.P. 8th Ed., Rev. 2, §2141.02, citing W.L. Gore & Associates v Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983).

In the present case, Taylor does disclose the use of metal rods that are incorporated into the shutter. According to Taylor, the two vertical side members are comprised of polyvinyl chloride and define a channel to hold a strengthening rod. The strengthening rod is a hollow aluminum rod. Col. 1, ll. 37-47.

In stark contrast to the present invention, however, Taylor goes to great lengths to “hide” the aluminum rods from view and to ensure that they are imbedded within the shutter as opposed to forming exterior vertical edges. For instance, Taylor describes square-shaped channels that are extruded in each vertical side member 11. Col. 3, line 11. The aluminum rods are then placed in the channels so that they are completely encased within the polyvinyl chloride. Taylor also describes small “cut-outs” that are placed over the square-shaped channels in order “to conceal the ends of the aluminum rods.”

Furthermore, the metal rod inserts of Taylor are used only for reinforcement of the shutter. In stark contrast, the first and second channel members of the present

application, not only reinforce, but also consolidate the entire structure by enclosing the vertical edges of the shutter. Pg. 8, ll. 18-21.

Thus, as described above, Taylor not only fails to disclose or suggest first and second metal channel members that form exterior vertical edges of a shutter but actually teaches away from the claimed construction. As such, Appellants submit that one of ordinary skill in the art would be discouraged modify the shutter disclosed by Taylor to come up with the presently claimed shutter.

B. No motivation, incentive, or suggestion exists to combine the cited references as suggested by the Office Action.

Obviousness may only be established by modifying the teachings of the prior art to produce the claimed invention if there is some teaching, suggestion, or motivation to do so found either in the reference itself or in the knowledge generally available to one of ordinary skill in the art. See e.g., *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

Accordingly, even if all elements of a claim are disclosed in various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill would have been prompted to modify the teachings of the references to arrive at the claimed invention. See e.g., *In re Regel*, 188 U.S.P.Q. 132 (C.C.P.A. 1975). Where no reasonable intrinsic or extrinsic justification exists for the proposed modification, a case of *prima facie* obviousness will not have been established.

In the Office Action, Taylor was combined with Ruggles in rejecting the claims in order to overcome the deficiencies of the disclosure of Taylor. Ruggles is directed to an adjustable shutter assembly having an automated adjustment system including an electronic actuating device. Ruggles merely states in column 6 that the frame of the shutter assembly may be constructed of various materials including wood, metal, plastics, ceramics and combinations thereof.

Ruggles, however, provides no motivation, incentive or suggestion to modify the shutter disclosed in Taylor in arriving at the claimed invention. In fact, as stated above, Taylor teaches away from a shutter that includes exposed areas made from a metal and

teaches away from including metal channel members that form the exterior vertical edges of a shutter. Thus, Taylor expressly teaches away from combining the teachings of Ruggles to modify the apparatus disclosed in Taylor.

As such, Appellants respectfully submit that it would not have been obvious to combine Ruggles with Taylor to arrive at the claimed invention. Any such combination rests solely on improper hindsight analysis. Only with Applicants' specification could the structure of any of the independent claims be attained, and any attempt to arrive at the structure of the claims through study of the cited references is only reachable from improper hindsight analysis after viewing Applicants' specification.

Appellants emphasize that the teachings of the references must be viewed in their entirety, i.e., as a whole, to sustain a prima facie case of obviousness under 35 U.S.C. §103(a). Further, the appropriate test under 35 U.S.C. §103(a) is not whether the differences between the prior art and the claims are obvious, but instead whether the claimed invention as a whole would have been obvious. That is, the differences between a particular claim and the cited references cannot be viewed in a vacuum. In this case, Appellants respectfully submit that, when properly viewed as a whole, there is simply no motivation to combine the references in the manner suggested in an attempt to render obvious the present claims.

8. Conclusion

In summary, Appellants respectfully submit that the presently pending claims patentably define over the prior art of record and are in complete condition for allowance. Favorable action, therefore, is respectfully requested.

Respectfully submitted,
DORITY & MANNING, P.A.



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2-22-05

Date

EXHIBIT A: PENDING CLAIMS

1. A shutter comprising:

a face panel made from a synthetic polymer, said face panel including a first vertical end portion and a second vertical end portion;

a first rear vertical support and a second rear vertical support attached to said face panel, said rear vertical supports being spaced apart and extending along the length of said face panel, said first rear vertical support being positioned adjacent to said first vertical end portion and said second rear vertical support being positioned adjacent to said second vertical end portion; and

at least one rear horizontal support attached to said face panel, said rear horizontal support extending in between said pair of rear vertical supports; and

a first channel member and a second channel member, each of said channel members having a U-shaped cross-section and being made from a metal, said first channel member being placed over and enclosing said first vertical end portion and said first rear vertical support and said second channel member being placed over and enclosing said second vertical end portion and said second rear vertical support, the first and second channel members forming exterior vertical edges of the shutter.

2. A shutter as defined in claim 1, wherein said face panel is made from an expanded foam polyvinyl chloride.

3. A shutter as defined in claim 2, wherein said first and second rear vertical supports and said at least one rear horizontal support are made from an expanded foam polyvinyl chloride.

4. A shutter as defined in claim 1, wherein said first and said second rear vertical supports are attached to said face panel using an adhesive.

5. A shutter as defined in claim 1, wherein each of said vertical end portions and said rear vertical supports include indentations, and wherein said channel members define raised elements that reside in said indentations.

6. A shutter as defined in claim 1, wherein said face panel is coated with a lacquer coating.

7. A shutter as defined in claim 1, wherein said shutter includes at least two rear horizontal supports.

8. A shutter as defined in claim 1, wherein said first and said second channel members are made from aluminum.

9. A shutter as defined in claim 1, wherein said face panel includes routed out decorative areas.

10. A shutter as defined in claim 1, further comprising a polymer film positioned in between said face panel and said first and said second rear vertical supports and between said face panel and said at least one horizontal support.

11. A shutter comprising:

a face panel made from a synthetic material, said face panel including a first vertical end portion and a second vertical end portion;

a back panel comprising first and second rear vertical supports attached to said face panel, said rear vertical supports being spaced apart and extending along the length of said face panel, said first rear vertical support being positioned adjacent to said first vertical end portion and said second rear vertical support being positioned adjacent to said second vertical end portion, said first and second rear vertical supports being made from a synthetic material; and

a first channel member and a second channel member, each of said channel members having a U-shaped cross-section and being made from a material comprising a metal, said first channel member being placed over and enclosing said first vertical end portion and said first rear vertical support, said second channel member being placed over and enclosing said second vertical end portion and said second rear vertical support, the first and second channel members forming exterior vertical edges of the shutter.

12. A shutter as defined in claim 11, wherein said first and said second channel members are made from aluminum.

13. A shutter as defined in claim 11, wherein said face panel and said back panel are made from a material comprising an expanded foam polyvinyl chloride.

14. A shutter as defined in claim 11, wherein each of said vertical end portions and said rear vertical supports include indentations and wherein said channel members define raised elements that reside in said indentations.

15. A shutter as defined in claim 14, wherein said first and said second channel members extend the entire length of said face panel.

16. A shutter as defined in claim 15, wherein said indentations located on said vertical end portions and said rear vertical supports comprise vertical slots that extend the length of said shutter, and wherein said raised elements defined by said channel members also extend the length of said shutter.

17. A shutter comprising:

a face panel made from an expanded foam polyvinyl chloride, said face panel including a first vertical end portion and a second vertical end portion;

a rear support section attached to said face panel, said rear support section including a first rear vertical support and a second rear vertical support, said first and second rear vertical supports being made from an expanded foam polyvinyl chloride, said first rear vertical support being positioned adjacent to said first vertical end portion and said second rear vertical support being positioned adjacent to said second vertical end portion; and

a first channel member and a second channel member that form exterior vertical edges of the shutter, each of said channel members having a U-shaped cross-section and being made from a metal, said first channel member being placed over and enclosing said first vertical end portion and said first rear vertical support, said second channel member being placed over and enclosing said second vertical end portion and said second rear vertical support, and wherein each of said vertical end portions and said rear vertical supports include an indentation and wherein said channel members define raised elements that reside in said indentations.

18. A shutter as defined in claim 17, wherein said back support section further includes at least one horizontal support extending in between said pair of rear vertical supports.

19. A shutter as defined in claim 17, wherein said first and said second channel members are made from aluminum.

20. A shutter as defined in claim 17, wherein said indentations located on said vertical end portions and said rear vertical supports comprise vertical slots that extend the length of said shutter, and wherein said raised elements defined by said channel members also extend the length of said shutter.